3742

#7 amd 6/12/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Pollack

Serial No.: 09/939,993 Group No.: 3742

Filed: August 27, 2001 Examiner: J. Jeffery

For: FORCED AIR DRYER FOR INFANT'S BOTTOM

RESPONSE TO OFFICE ACTION

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In response to the Office Action mailed February 5, 2002, the Examiner's attention is directed to the following remarks.

Claims 1-7 and 13-15 are pending in the application. Claims 1-3, 5-7, 13 and 15 stand rejected under 35 U.S.C. §103(a) over DE 2637484 in view of Caruso (U.S. 3,836,750). Claims 4 and 14 stand rejected under 35 U.S.C. §103 over this combination, and further in view of other references discussed below. The claims of this application are being resubmitted without amendment, however, because the Examiner has failed to establish *prima facie* obviousness.

DE 2637484A Is Non-Analogous Art

To rely on a reference under 35 U.S.C. §103, it must be analogous prior art. If a reference is used as the basis for rejection of an Applicant's invention, the reference must either be in the field of Applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992); In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); and In re Clay, 966 F.2d 656, 659, 23

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USPQ2d 1058, 1060-61 (Fed. Cir. 1992). A reference is reasonably pertinent if it would have been referred to in considering the problem facing the inventor. Wang Laboratories vs. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993).

In this case, the DE 2637484 reference resides in a hand-held heater for thawing frozen vehicle door locks. This is certainly not in the field of Applicant's endeavor, and it is not reasonably pertinent to the particular problem with which Applicant is faced. The Examiner's statement that "the outermost end of nozzle 1 is made of rubber so that the surface to be heated is not damaged by contact therewith," is apparently a fabrication, because that is not what the reference states. Rather, the reference states that "the opposite end of the case incorporates a rubber nozzle, interchangeable to suit different vehicles ...". This, in fact, is a further confirmation that this reference is unrelated to Applicant's field of endeavor and the problem facing the instant inventor.

Although Applicant has not claimed the temperature or temperature range desired, reference is made to the fact that Applicant's invention is intended to dry a moist region of a person's body, including babies. The Examiner's comments regarding "mere intended use" notwithstanding, given that inventions must be taken as a whole, DE 2637484A simply does not apply. Indeed, the abstract states that the device resembles "a hand torch," an implication that would clearly teach away from its use on a human body, particularly that of a child or infant. Nor would anyone of skill in the art of *body-part drying apparatus* consider "hand torches" of the type used to unfreeze vehicle door locks. Applicant is not claiming any kind of a hand-held heater that *could be* used to dry human body parts; if that were the case, hair dryers, blow torches and space heaters would all apply. Obviously they do not.

There is No Motivation to Combine the References as Suggested by the Examiner

It is well settled in rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art, or to combine references, to arrive at Applicant's claimed invention. There must be something *in the prior art* that suggests the combination, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior art references. In Re Dembeczak, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

In this case, there is no teaching or suggestion *whatsoever* from the prior art that would motivate one of any skill to combine DE 2637484A and Caruso. The Examiner states that "in view of Caruso (U.S. 3,836,750), it would have been obvious to one of ordinary skill in the art to provide auxiliary ports in conjunction with the main outlet of the previously described apparatus so that back pressure is relieved via the additional ports if the main outlet is blocked." This is pure conjecture on the part of the Examiner, with no support at all *from the prior art*. There is no statement in DE 2637484A that the blocking of a "main outlet" is a problem. Indeed, given that this reference teaches an opposite end of the case interchangeable *to suit different vehicles*, would lead one to conclude that an intimate "blocked" contact with the door lock to be thawed is desirable, and not the opposite, as suggested by the Examiner.

Claim 4 stands rejected over the DE 2637484A/Caruso combination, and further in view of Martin (U.S. 1,660,802). Claim 4 adds to claim 1 the limitation of a lamp mechanically associated with the housing so as to illuminate a region to which the air is directed. Claim 4 is allowable on at least the

grounds that DE 2637484A is non-analogous art, and the DE 2637484A/Caruso combination is unsupported, for all of the reasons set forth above. The Examiner states that "it would have been obvious ... to provide a lamp in conjunction with the heated air blower ... thereby precluding the need for additional lights and electric power sources therefore." Again, other than the Examiner's own opinion, where, in the prior art, (other than Applicant's disclosure and claims) does such a conclusion find support?

Claim 14 stands rejected under 35 U.S.C. §03 over the DE 2637484A/Caruso combination and further in view of Chimera (U.S. 5,394,620). Claim 14 is allowable on at least the grounds that DE 2637484A is non-analogous art, and the DE 2637484A/Caruso combination is unsupported, for all of the reasons above. Claim 14 adds to claim 13 electrical contacts adapted to allow recharging of the battery, mounted in a hand grip. The Examiner states that it would be obvious to one of skill in the art to add such contacts for the reason that rechargeable batteries are used; that is, "precluding the need to replace batteries when they are run down." Apart from the fact that there is no teaching or suggestion from any of these three references as to the combination proposed by the Examiner, it is noted that if one were to combine DE 2637484A and Caruso, which power source "one of skill in the art" choose? If it is the power source of Caruso, that would be a high-current supply which could not be put into any sort of rechargeable battery, at least not with respect to a hand-held device.

Based upon the foregoing, Applicant believes that all claims continue to be in condition for allowance. Submitted herewith are drawings changes to Figures 3-8 to provide cross-hatching in the form of a resilient material.

Respectfully submitted,

By: _____

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Date: May 6, 2002

CERTIFICATE OF MAILING (37 CFR 1.8(a))

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

Date: 5/6/02

Sheryl L. Hammer